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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,646	01/20/2004	Brian J. Lowe	1001.1653101	5311

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EXAMINER

SAM, CHARLES H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary	Application No. 10/762,646	Applicant(s) LOWE ET AL.	
	Examiner Charles H. Sam	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3,9-12,15,20-22,24,25,30-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Renati et al. 2004/0044359. Renati discloses a device for use with an embolic protection filter comprising an elongate sheath having a proximal region, a distal region, a lumen extending therethrough, and a distal mouth disposed adjacent the distal region; wherein the distal mouth is expandable and is adapted to shift between a basal configuration and an enlarged configuration; and wherein the distal region includes a bulbous member in the basal configuration. Note figures 3-12.

Regarding claim 2, Renati discloses the bulbous member including a tapered proximal edge and a tapered distal edge. See figures 6-12.

Regarding claim 3, Renati discloses the proximal region of the sheath attached to the distal region of the sheath. See figure 6.

Regarding claims 9-12,32-34, note figures 7-8.

Regarding claim 15, note figure 10.

Regarding claims 20-22, Renati discloses the grooves 364.

Regarding claim 24, note figure 10.

Regarding claim 25, note figures 5-6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-14 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renati et al. 2004/0044359 in view of Monroe et al. 6322586. Renati discloses the invention as claimed except for a coil. However, Monroe discloses as shown in figures 16-17 a distal region including a support coil. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Renati by adding a coil in view of Monroe to provide rigidity or flexibility of the distal region.

Regarding claim 12-13, note figure 16 of the Monroe et al. reference.

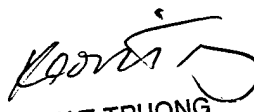
3. Claims 4-8,16-18,23,26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renati et al. 2004/0044359 in view of Johnson et al. 6596011. Renati discloses the invention as claimed except for a braid. However, Johnson discloses a sheath reinforced with braid. See column 6, lines 58-61, and column 9, lines 53-55. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Renati by including a braid in view of Johnson to provide more strength to the sheath.

4. Claims 19 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renati et al. 2004/0044359 in view of Johnson et al. 6596011 as applied to claims 4-8, 16-18, 23, 26-28 above, and further in view of Auth 4646736. Renati in view of Johnson discloses the invention as claimed except for a radiopaque material. However, Auth discloses a sheath 16 comprising a radiopaque material 38. Note column 3, lines 59-66. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to further modify Renati by adding a radiopaque material to the braid of the distal region to provide means for tracking the distal region when it moves through the patient vessel.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Sam whose telephone number is (571) 272-4703. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


KEVIN T. TRUONG
PRIMARY EXAMINER

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHS

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March 14, 2005